

**REMARKS**

**I. STATUS OF THE CLAIMS**

Claims 1 and 3-44 are currently pending in this application. Claims 1 and 25 has been amended. Support for these amendments are found in the specification, for example, at page 1, lines 4-10 and the claims as-filed. Thus, Applicants submit that no new matter has been added.

Applicants acknowledge and appreciate the Examiner's withdrawal of the Section 103 rejection of claims 1 and 3-44 over U.S. Patent No. 2,940,983 ("*Sartori*") in view of U.S. Patent No. 3,856,026 ("*Gaydos*"). Applicants also acknowledge and appreciate that the Examiner has found claims 25-44 not obvious over the prior art. Office Action at 4.

**II. REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

The Examiner has rejected claims 1, 3-5, and 16-44 under 35 U.S.C. § 112, second paragraph as indefinite for the reasons disclosed at page 2 of the Office Action. Specifically, the Examiner objects to the claims' description of possible R groups as dialkylsiloxane radicals with a repeating unit because the description does not expressly provide the terminal group. *Id.* Applicants respectfully traverse this rejection for at least the reasons presented below.

It is well-established that so long as one of ordinary skill in the art can recognize the scope of the term in view of the specification, the teachings of the prior art, and the proper claim interpretation, those claim terms are definite. See M.P.E.P. § 2173.02. Thus, the question is not whether a term is expressly defined in the claim or specification, but whether a person of ordinary skill in the art would nevertheless

recognize the meaning. See *Ex parte Balzarini*, 21 U.S.P.Q.2d 1892, 1898 (Bd. Pat. App. & Int. 1991).

Applicants submit that a person of ordinary skill in the art would recognize the structure shown in the claims, as a common, everyday description of a dialkylsiloxane radical. For example, see [www.psrc.usm.edu/macrog/silicone.htm](http://www.psrc.usm.edu/macrog/silicone.htm), which is a introductory polymer chemistry discussion showing specific examples of such radicals, including polydimethylsiloxane, polymethylphenylsiloxane, and polydiphenylsiloxane. (A courtesy copy is provided). Each example is of the very same form used in the claims. Thus, Applicants' claim language is well known and understood in the art.

Furthermore, Applicants submit that a person of ordinary skill in the art would know that such radicals may terminate with a variety of possible substituents. The fact that the number of substituents is large cannot be a basis for alleging indefiniteness, particularly where Applicants intend to encompass all such substituents. See M.P.E.P. § 2173.04

Accordingly, Applicants respectfully request that this rejection be withdrawn.

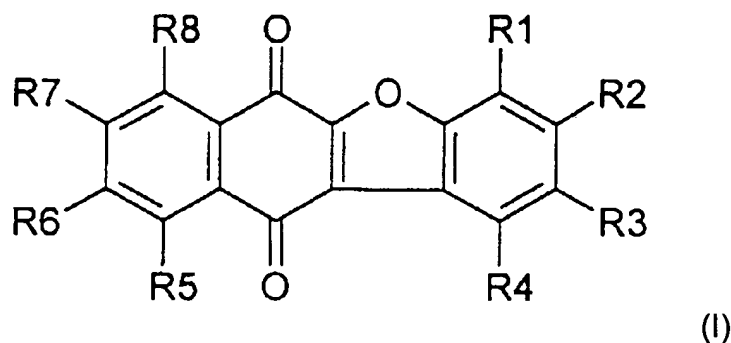
### III. **REJECTION UNDER 35 U.S.C. § 103(a)**

The Examiner has rejected claims 1 and 3-24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,940,983 ("*Sartori*") for the reasons disclosed at pages 3 and 4 of the Office Action. Applicants respectfully traverse this rejection for at least the reasons presented below.

As an initial matter, to establish a prima facie case of obviousness, the Examiner must show that (1) *Sartori* teaches or suggests all of the claim limitations, (2) a suggestion or motivation in *Sartori* or in the knowledge generally available to one of

ordinary skill in the art exists to modify the teachings of *Sartori* in order to recreate Applicants' claimed invention, and (3) a reasonable expectation of success exists for the modification of *Sartori*. See M.P.E.P. §§ 2143.01, 2143.02, and 2143.03. Applicants submit that Applicants' invention is not obvious over *Sartori*, because the Examiner cannot establish criteria (1) and (2), at a minimum.

Applicants' claims 1, and 3-24, as amended, recite make-up compositions comprising a cosmetically acceptable medium and at least one ingredient chosen from compounds of formula (I) and salts thereof:



"wherein said composition is suitable for use on skin, mucous membranes, and/or superficial body growths." See, e.g., claim 1.

*Sartori* discloses a series of halogen substituted dinaphthofurandiones. For example, *Sartori* discloses 8-chloro-dinaphtho-(1,2-2',3')furan-7,12-dione and 11-chloro-dinaphtho-(1,2-2',3')furan-7,12-dione. See col. 2, lines 45-65. However, *Sartori* does not teach or suggest that these compounds are suitable for make-up compositions. *Sartori* merely discloses that the compounds are useful as "disperse dyes for polyester fiber." Col. 1, lines 42-44.

**A. *SATORI* FAILS TO TEACH OR SUGGEST  
“A MAKE-UP” COMPOSITION.**

Applicants submit that the preamble of claims 1 and 3-24 is a limitation upon the scope of the claims, which distinguishes the claims over *Satori*. The Examiner has argued that “the preamble is generally not accorded any patentable weight.” Office Action at 3-4. Applicants respectfully traverse for at least the following three independent reasons:

- (1) a preamble is a limitation when one could not identify the scope of the claims without it,
- (2) a preamble is a limitation when it is intertwined with the body of the claims, and
- (3) a preamble is a limitation when applicants’ specification suggests that the invention is so limited.

Each independently justifies a determination that “make-up composition” is a limitation on all rejected claims.

First, as stated in the M.P.E.P., “a preamble has the import that the claim as a whole suggests for it.” M.P.E.P. § 2111.02. Here, the identification of (1) a specific group of cosmetically acceptable media and (2) a specific group of compounds derived from furan-naphthoquinone in the body of each rejected claim cannot alone define Applicants’ invention. See *Rowe v. Dror*, 42 U.S.P.Q.2d 1550, 1553 (Fed. Cir. 1997). Without the preamble, one could not identify the scope of the claims. As noted in Applicants’ specification, compounds derived from furan-naphthoquinone were known for other uses, but not necessarily as an ingredient in make-up compositions. Hence,

without the preamble, one of ordinary skill in the art would not know the scope of the claimed compositions.

Second, the Courts have held that one should consider whether the preamble is intertwined with the body of the claim. For example, in *Gerber Garment Technology Inc. v. Lectra Systems Inc.*, 16 U.S.P.Q.2d 1436 (Fed. Cir. 1990), the Court held the preamble, “a tool in the form of a cutting blade,” was a limitation upon the claims because of the later referral to “cutting blade” in the body of the claim. *Id.* at 1441; see also, *Rohm and Haas Co. v. Brotech Corp.*, 44 U.S.P.Q.2d 1459, 1461 n.1 (Fed. Cir. 1997). Here the preamble of the rejected claims recites “a make-up composition” and the body, as amended, recites “wherein said make-up composition is suitable for use on skin, mucous membranes, and/or superficial body growths.” Because of the repetition of language in the body, the preamble is integral to Applicants’ claims and is a limitation. See 16 U.S.P.Q.2d at 1441. Again, nothing in *Satori* suggests a make-up composition as presently claimed.

Third, whether or not the preamble is a structural limitation “can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim.” M.P.E.P. §2111.02; see also, *Corning Glass Works v. Sumitomo Electric U.S.A. Inc.*, 9 U.S.P.Q.2d 1962, 1966 (Fed. Cir. 1989). Here, Applicants’ specification makes it abundantly clear that Applicants did not invent all compositions that comprise the recited compounds derived from furan-naphthoquinone. Rather, Applicants invented and claimed only those compositions which are make-up compositions. In every instance, the invention is described in the specification in terms of cosmetics. Paraphrasing the Federal Circuit in

*Corning Glass Works*, “to read the claim in light of the specification indiscriminately to cover all types of [compositions] would be divorced from reality. The invention is restricted to those [compositions] that work as [hair styling compositions] as defined in the specification, which is not true with respect to [compositions] constructed with the limitations of [the recited compounds and media] only.” 9 U.S.P.Q.2d at 1966.

Finally, Applicants submit that its claims are like those of Robie in *Kropa v. Robie*, 88 U.S.P.Q. 478 (C.C.P.A. 1951). In *Kropa*, the Court held that the claim’s preamble, “an abrasive article,” was essential to define the scope of the claims that recited “abrasive grains and a hardened binder.” *Id.* at 481. To paraphrase the Court, not every union of a cosmetically acceptable medium and a compound derived from furan-naphthoquinone is a “make-up composition.” *See id.*

The phrase, a “make-up composition,” is a limitation that is “necessary to give life, meaning, and vitality” to Applicants’ claims and which *Satori* does not explicitly or inherently teach. Rather, *Satori* merely teaches a “disperse dye” for dyeing polyester fibres. Col. 1, lines 41-49. Nothing in *Satori* suggests a make-up composition.

**B. THERE IS NO MOTIVATION TO COMBINE SATORI’S COMPOUNDS IN A MAKE-UP COMPOSITION**

Applicants also submit that there is no suggestion or motivation in *Sartori* or in the knowledge generally available to one of ordinary skill in the art to modify the teachings of *Sartori* in an attempt to recreate Applicants’ claimed invention. M.P.E.P. §2143.01. As stated in *Satori*, the compounds are suitable as disperse dyes. Col. 1, lines 43. It is well-known that disperse dyes are for the coloring of synthetic fibers, such as nylon and polyester. *See* HAWLEY’S CONDENSED CHEMICAL DICTIONARY, 431 (13<sup>th</sup> Ed.

1997). This is consistent with *Satori*'s own declaration that the disperse dyes were for polyester fibers. Col. 1, lines 43-48. Thus, there is no suggestion in *Satori* that such a compound may be useful for "skin, mucous membranes, and/or superficial body growths," as required by the amended claims.

Applicants submit that it is only Applicants' specification that suggests for the first time that such a compound may be used to color "skin, mucous membranes, and/or superficial body growths." However, it is axiomatic that Applicants' specification is unavailable to provide such a motivation. M.P.E.P. § 2143.

Moreover, one cannot base a determination of obviousness on what the skilled person might try or find obvious **to try**. See *e.g.*, M.P.E.P. § 2145, Section X, Subsection B. Rather, the proper test requires determining what the prior art would have led the skilled person **to do**. The Federal Circuit has given some examples of what would constitute an "obvious to try" modification based on the prior art. See In re O'Farrell, 7 U.S.P.Q.2d 1673 (Fed. Cir. 1988). For example, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it." *Id.* at 1681 (citations omitted). In the present case, *Satori* provides guidance to color polyester; however, that is not guidance for human body surfaces, which are significantly more delicate and susceptible to problems (toxicity, allergy, etc.) than synthetic surfaces.

For at least these reasons, Applicants maintain that the Examiner has not set forth a prima facie case of obviousness. Accordingly, Applicants request that this rejection be withdrawn.

**IV. CONCLUSION**

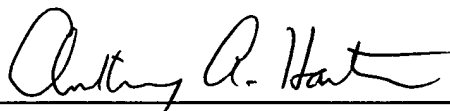
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: April 2, 2004

By:   
Anthony A. Hartmann  
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Attachments: [www.psrc.usm.edu/macrog/silicone.htm](http://www.psrc.usm.edu/macrog/silicone.htm)  
HAWLEY'S CONDENSED CHEMICAL DICTIONARY, 431 (13<sup>th</sup> Ed. 1997).